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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/939,896 | 08/27/2001 | Lane W. Lee | M-12042 US | 4074 |

7590 07/28/2006

MACPHERSON KWOK CHEN & HEID LLP
1762 TECHNOLOGY DRIVE
SUITE 226
San Jose, CA 95110

EXAMINER

BAYAT, BRADLEY B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3621

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 09/939,896 | Applicant(s) LEE ET AL. | |
| | Examiner Bradley B. Bayat | Art Unit 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 15, 2006 has been entered.

Status of Claims

This communication is in response to amendment and remarks filed on May 15, 2006.

- Claims 36 and 40 have been amended.
- Claims 42 and 43 have been cancelled.
- Claims 1-35 and 41 were previously cancelled.
- Claims 36-40 remain pending.

Response to Arguments

Applicant's arguments filed May 15, 2006 have been fully considered but they are not persuasive.

Applicant argues that the cited reference Nonaka “describes no revocation whatsoever between the network device and the content provider (response p. 4).” In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies as noted above are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant also argues that even if Nonaka did describe revocation in the above-argued context, such revocation would be with regard to the entire secure container and not to specific files within the secure container. *Id.* In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies as noted above are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, the claim is directed to a "method of revoking a host device" rather than a granular, file-by-file revocation scheme (response p. 5).

Nonaka anticipates applicant's amendment of "establishing a secure session by transmitting a session key to the host device" in that it can be mutually authenticated utilizing a session key each time [0427-0444].

Applicant further argues that the rule as applied in the claims is associated with a revocation file rather than a revocation list (response p. 7). The examiner cannot find support in the specification for a "revocation file" and therefore cannot determine any meaning beyond the disclosure in describing a revocation list. The applicant should point as support by page and line number wherein a "revocation file" is defined in the disclosure.

Claim Rejections - 35 USC § 112, 1st paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 36 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant refers to a “revocation file” in the claim; however, the examiner has not been able to find support for this language in the disclosure. The applicant should indicate where in the disclosure by page and line number such support is found.

Claim Rejections - 35 USC § 112, 2nd paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- As per claim 36, the limitation “if the application of the at least one rule provides a failing result, denying the file request” is merely intended use and does not impart a definite limitation.
- As per claim 40, the limitation “if the application of the at least one rule provides a successful result, granting the file request” fails to impart a definite limitation since the step is optional.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 36-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Nonaka et al. (hereinafter Nonaka), US 2003/0046238 A1.

As per the following claims, Nonaka discloses:

36. A method of revoking a host device comprising:

- receiving at a storage engine a certificate from the host device, the certificate containing a digital signature (§435);
- authenticating the digital signature (§22-28, 54-66; figures 60, 61 and associated text);
- establishing a secure session by transmitting a session key to the host device (§427-444); and during the secure session:
- receiving at the storage engine a file request from the host device, the file request being directed to a file stored on a storage medium accessible to the storage engine (§435, 671-675);
- reading a revocation list associated with the file from the storage medium, the revocation file containing at least one rule, the at least one rule associating data in the revocation file with data in the certificate (§435, 671-675);
- applying the at least one rule on the data in the revocation file and the associated data in the certificate (§247); and

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- if the application of the at least one rule provides a failing result, denying the file request (§§671-675; figures 60-61).

37. The method of claim 36, wherein the at least one rule comprises a plurality of rules (§§247, 857, 1085-1087).

38. The method of claim 36, wherein the storage medium is an optical disk (§221).

39. The method of claim 36, wherein the application of the at least one rule act comprises matching the data in the revocation file with the data in the certificate (§§225, 256, 283).

40. The method of claim 36, further comprising: if the application of the at least one rule provides a successful result, granting the file request (§§262-276; 359-370).

41. CANCELED.

42. CANCELED.

43. CANCELED.

Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday - Friday 8 a.m.-6:30 p.m. and by email: bradley.bayat@uspto.gov. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached regarding urgent matters at 571-272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 571-272-6584.

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Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 2231-1450

Or faxed to:

(571) 273-8300 - Official communications; including After Final responses.

(571) 273-6704 - Informal/Draft communications to the examiner.

A handwritten signature in black ink, appearing to read "Bradley Bayat", with a stylized horizontal line extending from the end.

Bradley B. Bayat, Esq.
Department of Commerce - USPTO
KNOX - 5A48
Technology Center 3600
Art Unit 3621 - Patent Examiner
(571) 272-6704 Direct Dial
(571) 273-6704 Direct Fax
(571) 273-8300 Official Central Fax